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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/733,760	12/12/2003	John Charles Calhoon	003797.00690	8738
28319	7590	06/16/2005		
BANNER & WITCOFF LTD., ATTORNEYS FOR MICROSOFT 1001 G STREET, N.W. ELEVENTH STREET WASHINGTON, DC 20001-4597			EXAMINER BERHANU, SAMUEL	
			ART UNIT 2838	PAPER NUMBER

DATE MAILED: 06/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/733,760

Applicant(s)

CALHOON ET AL.

Examiner

Samuel Berhanu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 26-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12/12/2003.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C.

121:

- I. Claims 1-25 drawn to inductive battery charging system , classified in class 320, subclass 108.
- II. Claims 26-27, drawn to battery monitoring, classified in class 702, subclass 63.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as combination and subcombination.

Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed, since battery packs can be charged by a different system or method. The subcombination has separate utility such as a control and monitoring system.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

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4. Because these inventions are distinct for the reasons given above and the search required for Group II is not required for Group I, restriction for examination purposes as indicated is proper.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

6. During a telephone conversation with Mr. Motley on 4/24/2005 a provisional election was made without traverse to prosecute the invention of Group I. Affirmation of this election must be made by applicant in replying to this Office action. Claims 26-27 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Objections

8. Applicant is advised that should claim 24 is be found allowable, claim 25 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is

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proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Double Patenting

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 1-25 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-25 of copending Application No. 10/733850 in view of Stephens (US,5,734,254)

This is a provisional obviousness-type double patenting rejection.

Claims 1-25 of Application No. 10/733850 discloses the claimed invention with the exception of the apparatus being a battery pack. However, Stephens discloses a battery pack in Figure 1, element 10. It would have been obvious to a person having ordinary skill in the art at the time of the invention to accommodate a battery pack in the power adapter of Application No. 10/733850 as taught by Stephens in order to charge batteries and power electronic devices.

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11. Claims 1-21 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-21 of copending Application No.10/733820. Although the conflicting claims are not identical, they are not patentably distinct from each other because they disclose a method and system for effective charging and monitoring batteries. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

DETAILED ACTION

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13. Claims 1, 3-5 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Stephens (US 5,734,254).

Regarding claim 1, Stephens discloses in Figures 1 and 2 an apparatus for transmitting inductive energy to a battery pack (10), the battery pack including a microprocessor (20) for processing data relevant to the inductive energy, the apparatus comprising: a memory (50) for storing computer readable instructions relevant to charging a battery pack (10); a processor unit (50) operatively coupled to the memory; and a transmission element (32,62) operatively coupled to the processor so as to provide the inductive energy to the battery pack.

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Regarding claim 3, Stephens discloses a communications device for receiving and transmitting data (20,50) and the communications device being operatively coupled to the transmission element (24,54)

Regarding claim 4, Stephens discloses an apparatus further comprising an antenna (24,54) and a communications device configured to receive (24,54) the computer readable instructions and configured to transmit (24,54) the instructions to the antenna for wireless data communications to a battery pack (Column 3, lines 41-49).

Regarding claim 5, Stephens discloses a processor unit (50) is configured to receive a plurality of charging parameters from the battery pack (Column 3, lines 59-67, column 4, lines 1-6).

Regarding Claim 7, Stephens discloses an apparatus comprising a plurality of transmission elements each configured to operate independently of each other (24, 38, 68, 54,32,62).

14. Claims 8, 10 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Parks et al. (US 5,455,466).

Regarding claim 8, Parks et al disclose a battery pack configured for receiving inductive energy for charging (200b) comprising: a processor unit (228) for processing computer readable data relevant to receiving the inductive energy and for processing data communication with a computer system; a pick up coil (200b) configured for receiving the inductive energy; a charger operatively coupled to the processor unit and the pick up coil (224); the charger configured to

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output a direct current responsive to the inductive energy (222); and an energy storage unit (225) configured for receiving the direct current.

Regarding claim 10, Parks et al disclose the battery pack comprising a communications device (220) operatively coupled to the pickup coil (220).

Regarding claim 11, Parks et al disclose the battery pack in which the communications device (220) is configured to receive the computer readable data and transmit the data to the pick up coil (200b).

15. Claims 16, 17, 19, 22 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Garcia et al. (US 5,963,012).

Regarding claims 16 and 22, Garcia et al discloses in Figures 2 and 3 a computer implemented method of charging battery pack, comprising the step of: receiving a polling message from a charging source (Column 2, lines 47-59); transmitting a request for power to the charging source (204); and receiving inductive power from the charging source (Column 2, lines 30-59).

Regarding claims 17 and 23, Garcia et al. disclose the step of transmitting includes a step of transmitting charging parameters to the charging source (column 2, lines 47-59).

Regarding claim 19, a step of initiating a charger responsive to the step of receiving (Column 2, lines 30-59).

Claim Rejections - 35 USC § 103

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to

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be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claim 2 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stephens (US 5,734,254) in view of Stobbe (US 6,275,143).

Regarding claim 2, Stephens discloses the claimed invention, except the apparatus in which the memory includes authentication data for authenticating the battery pack for the inductive energy transmission. However Stobbe discloses the apparatus in which the memory includes authentication data for authenticating the battery pack for the inductive energy transmission (Column 6, lines 5-20). It would have been obvious to a person having ordinary skill in the art at the time of the invention to implement authentication data transfer means in Stephens battery pack and charging system as taught by Stobbe in order to protect against unintentional or unwanted battery charging.

Regarding claim 6, Stobbe discloses a processor unit (18) is configured to receive a digital security certificate from a battery pack (Column 6, lines 5-20).

18. Claims 9, 13 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parks et al. (US 5,455,466) in view of Stobbe (US 6,275,143).

Regarding claim 9, Parks et al disclose the claimed invention, except the processor unit is configured to provide authentication data for inductive energy charging. However, Stobbe discloses the apparatus in which the memory includes authentication data for authenticating the battery pack for the inductive

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energy transmission (Column 6, lines 5-20). It would have been obvious to a person having ordinary skill in the art at the time of the invention to implement authentication data transfer means in Parks et al . inductive coupling system as taught by Stobbe in order to protect against unintentional or unwanted battery charging.

Regarding claim 13, Stobbe disclose the processor unit is configured to provide a digital security certificate to a charging source (Column 6, lines 5-20).

Regarding claim 15, Stobbe discloses the an antenna (52) and a communications device (22,24) configured to receive the computer readable data and configured to transmit the data to the antenna for wireless data communications a charging source (Column 5, lines 35-45).

19. Claims 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Parks et al. (US 5,455,466) in view of Garcia et al. (US 5,963,012).

Regarding claim 12, Parks et al. disclose the claimed invention, except the processor unit is configured to provide a plurality of charging parameters to a charging source which provides the inductive energy. However, Garcia et al. disclose the processor unit is configured to provide a plurality of charging parameters to a charging source, which provides the inductive energy. It would have been obvious to a person having ordinary skill in the art at the time of the invention to modify Parks et al. inductive coupling system in order to transmit battery parameters as taught by Garcia et al. so that the device can make any necessary charging adjustments.

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20. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Parks et al. (US 5,455,466) in view of Higuchi et al. (US 6,163,132).

Regarding claim 14, Parks et al disclose the claimed invention, except the processor unit is configured to send data to the computer system so as to indicate it is receiving inductive energy. However, Higuchi discloses in Figure 1 the processor unit (4b) is configured to send data to the computer system (5) so as to indicate it is receiving inductive energy (Column 4, lines 33-38). It would have been obvious to a person having ordinary skill in the art at the time of the invention to add a computing and indicating system to the battery pack in Parks et al. as taught by Higuchi et al. in order to monitor battery status.

21. Claims 18, 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garcia et al. (US 5,963,012) in view of Stobbe (US 6,275,143).

Regarding claim 18, 24 and 25, Garcia et al. disclose the claimed limitation, except the step of transmitting includes a step of transmitting authenticating data to charging source. However, Stobbe discloses the step of transmitting includes a step of transmitting authenticating data to charging source. It would have been obvious to a person having ordinary skill in the art at the time of the invention to implement authentication data transfer means in Garcia et al. wireless battery charging system as taught by Stobbe in order to protect against unintentional or unwanted battery charging.

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22. Claims 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garcia et al. (US 5,963,012) in view of Higuchi et al. (US 6,163,132).

Regarding claim 20, Garcia et al. disclose the claimed invention, except a step of transmitting data to a computer system for indicating the step of receiving inductive power. However, Higuchi et al disclose in Figures 1 and 2 a step of transmitting data to a computer system for indicating the step of receiving inductive power (Column 4, lines 33-38). It would have been obvious to a person having ordinary skill in the art at the time of the invention to add a computing and indicating system to the battery pack in Garcia et al. as taught by Higuchi et al. in order to monitor battery status.

Regarding claim 21, Higuchi et al disclose in Figure 3 a step of displaying an object on a graphical user interface (6) indicative of the step of receiving (Column 4, lines 60-63).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samuel Berhanu whose telephone number is 571-272-8430. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Sherry can be reached on 571-272-2084. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SB

Handwritten signature and date: 6/13/05